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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/762,629

05/14/2001

Morten Jorsboe

9192.15USWO

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7590

04/22/2004

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EXAMINER

KALLIS, RUSSELL

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/762,629

Applicant(s)

JORSBOE ET AL.

Examiner

Russell Kallis

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

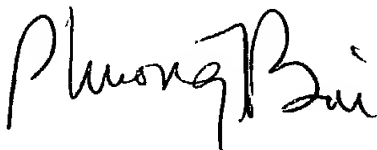
Claim(s) rejected: 74-90.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 09 February 2001 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 5. does NOT place the application in condition for allowance because: The rejection under 35 USC 112 1st paragraph, written description, that the specification does not adequately describe a representative number of polynucleotides encoding enzymes useful to convert galactose to UDP-glucose is maintained for reasons of record. While Applicant need not explicitly describe each and every species of a claimed genus to meet the written description requirement Applicant must provide a representative number of species within the genus to allow one of skill in the art to reliably predict the structure of other species within the genus. In Applicant's disclosure, Applicant has disclosed only 1 polynucleotide sequence encoding 1 enzyme that directly converts galactose to UDP-glucose from 1 of the 4 enzyme families useful to convert galactose to glucose and 1 species is not deemed adequate to encompass the genus of all enzymes useful to convert galactose to glucose from 4 very different enzyme families. It is noted that Applicant may not incorporate information from websites into Applicant's disclosure as websites are often updated and thus are not considered part of Applicant's original disclosure.

The rejection under 35 USC 112 1st paragraph, lack of enablement, that the claimed polynucleotides and the encoded enzymes are not adequately described in Applicant's specification and that some of the claimed enzymes having different biochemical mechanisms specified in Applicant's disclosure do not directly convert galactose to UDP glucose such that one cannot make and use such enzymes, or the polynucleotides encoding them, is maintained for reasons of record. Contrary to Applicant's assertion that it is irrelevant which upstream enzyme is selected for transformation, it is not irrelevant since the claimed enzymes have different biochemical mechanisms and are involved in different parts of the biochemical pathway involving galactose and are connected either directly or indirectly to other pathways, one skilled in the art would not know which "upstream enzyme" would be useful for the recited conversion of galactose to UDP-glucose, or how far upstream one can go and still be able to affect the recited conversion of galactose to UDP-glucose. Additionally, Applicant's arguments are not commensurate in scope with the claims as the claims are not limited to UDP-glucose epimerase.

  
PHUONG T. BUI  
PRIMARY EXAMINER 4/21/04